

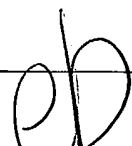


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,618	12/20/2001	Andreas Kramer	PP/1-22042/A/CGM 499/PCT	1679
324	7590	09/01/2004	EXAMINER TESKIN, FRED M	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			ART UNIT 1713	
DATE MAILED: 09/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,618	Applicant(s) KRAMER ET AL.	
	Examiner Fred M Teskin	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8-17, 19-25 and 27-29 is/are pending in the application.
4a) Of the above claim(s) 16 and 27-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 4, 8-15, 17 and 19-25 is/are allowed.
- 6) ☒ Claim(s) 2 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The Amendment of May 21, 2004 has been entered in full and is deemed to obviate the rejections (prior art and 35 U.S.C. 112), the objection and the requirement as set forth in the previous Office action.

Claim 1 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 8, 9 and 13-15, directed to species of the compound according to claim 1, are no longer withdrawn from consideration since all of the claims to these species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 16 and 27-29, directed to the species of compound of formula (IV), (V), (VI) or (VII), remain withdrawn from consideration since these claims do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species (i.e., claims 8, 9 and 13-15), applicants are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 2 and 6 are rejected under 35 USC 112, fourth paragraph, for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

Claims 2 and 6 fail to further limit the subject matter of the base claim insofar as Q₁ is defined in both claims as derived from "a mono ... functional alkylating agent", "a mono ... carboxylic acid ...", or "a mono ... isocyanate," and in claim 2 as derived from "a mono or polyepoxide" or from "POCl₃, SO₂Cl₂, BCl₃ or SiCl₄". Examiner notes the latest amendment to claim 1 restricts Q₁ to an organic radical derived from an (un)substituted triazine, from a *polycarboxylic acid* or *polycarboxylic acid derivative* having 2-6 carboxyl groups, from a *multifunctional* alkylating agent having 2-6 functional groups or from a *polyisocyanate* having 2-6 isocyanate groups (see claim 1, final three lines).

Since claims 2 and 6 can conceivably be infringed by matter which would not also infringe the basic claim (e.g., compounds wherein Q₁ is derived from a mono-functional alkylating agent, a mono-carboxylic acid, a mono-isocyanate or from POCl₃, SO₂Cl₂, BCl₃ or SiCl₄), these claims are deemed to be improper dependent claims (see MPEP 608.01 (n) under "Infringement Test" for dependent claims).

Claims 1, 3, 4, 8-15, 17, 19 and 20-25 are allowable on the present record.

The following is a statement of reasons for the indication of allowable subject matter: The amendment to claim 1 inserting the definitions of “n” and Q_1 as presented in claims 5 and 7 (now cancelled), respectively, is deemed to patentably distinguish the claimed compounds, and the (co)polymers and (co)oligomers prepared therewith, over the prior art. Further with respect to the products of claim 25, it is apparent from the specification (e.g., page 3, lines 6-10) that macromers prepared in the presence of the compounds of the present invention incorporate functional end-groups that come from the initiating radical of such compounds; therefore, the claimed products (i.e., (co)polymers and (co)oligomers) are deemed patentable on the basis of the degree of functionality and nature of the functional moieties attached to “A” in the formulae describing the compound of claim 1, which is used to prepare those products.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FRED TESKIN
PRIMARY EXAMINER
1713

FMTeskin/08-26-04